UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,730	11/13/2003	Matthew Dobson	AUS920030331US1	2685

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ART UNIT	PAPER NUMBER
3695	

NOTIFICATION DATE	DELIVERY MODE
04/15/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptonotifs@yeeiplaw.com

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 November 2007*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

  4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

  a)☐ All b)☐ Some * c)☐ None of:

    1.☐ Certified copies of the priority documents have been received.

    2.☐ Certified copies of the priority documents have been received in Application No. _____.

    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

  * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

Status of Claims

1.   This action is in reply to the Applicant's response filed on 30 November 2007.

2.   Claims 19-20 have been amended.

3.   Claims 1-20 are currently pending and have been examined.

Response to Arguments

37 CFR 1.131 Declarations

4.   The declarations filed on 25 July 2006 and 7 March 2007 under 37 CFR 1.131 have been considered but are ineffective to overcome the cited reference because the scope of the declarations are not commensurate with the scope of the claim(s). Furthermore, the declarations are not accompanied by evidence commensurate with the scope of the claim(s) to establish diligence from a date prior to the date of reduction to practice of the cited reference to either a constructive reduction to practice or an actual reduction to practice.

Evidence/Diligence

5.   The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the cited reference to either a constructive reduction to practice or an actual reduction to practice.

6.   An applicant must account for the entire period during which diligence is required. Gould v. Schawlow, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); In re Harry, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading). A 2-day period lacking activity has been held to be fatal. In re Mulder, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); Fitzgerald v. Arbib, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959) (Less than 1 month of inactivity during critical period. Efforts to exploit an invention commercially do not constitute diligence in reducing it to practice. An actual reduction to practice in the case of a design for a three-dimensional article requires that it should be embodied in some structure other than a mere drawing.); Kendall v. Searles, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949) (Diligence requires that applicants must be specific as to dates and facts.).

7.   The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. Rebstock v. Flouret, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975); Rieser v. Williams, 225 F.2d 419, 423, 118 USPQ 96, 100 (CCPA 1958) (Being last to reduce to practice, party cannot prevail unless he has shown that he was first to conceive and that he exercised reasonable diligence during the critical period from just prior to opponent's entry into the field); Griffith v. Kanamaru, 816 F.2d 624, 2 USPQ2d 1361 (Fed. Cir. 1987) (Court generally reviewed cases on excuses for inactivity including vacation extended by ill health and daily job demands, and held lack of university funding and personnel are not acceptable excuses.); Litchfield v. Eigen, 535 F.2d 72, 190 USPQ 113 (CCPA 1976) (budgetary limits and availability of animals for testing not sufficiently described); Morway v. Bondi, 203 F.2d 741, 749, 97 USPQ 318, 323 (CCPA 1953) (voluntarily laying aside inventive concept in pursuit of other projects is generally not an acceptable excuse although there may be circumstances creating exceptions); Anderson v. Crowther, 152 USPQ 504, 512 (Bd. Pat. Inter. 1965) (preparation of routine periodic reports covering all accomplishments of the laboratory insufficient to show diligence); Wu v. Jucker, 167 USPQ 467, 472-73 (Bd. Pat. Inter. 1968) (applicant improperly allowed test data sheets to accumulate to a sufficient amount to justify interfering with equipment then in use on another project); Tucker v. Natta, 171 USPQ 494,498 (Bd. Pat. Inter. 1971) ("[a]ctivity directed toward the reduction to practice of a genus does not establish, prima facie, diligence toward the reduction to practice of a species embraced by said genus"); Justus v. Appenzeller, 177 USPQ 332, 340-1 (Bd. Pat. Inter. 1971) (Although it is possible that patentee could have reduced the invention to practice in a shorter time by relying on stock items rather than by designing a particular piece of hardware, patentee exercised reasonable diligence to secure the required hardware to actually reduce the invention to practice. "[I]n deciding the question of diligence it is immaterial that the inventor may not have taken the expeditious course..").

8.   Furthermore, evidence drawn towards work on improvement of samples or specimens generally already in use at the time of conception that are but one element of the oscillator circuit of the count does not show diligence towards the construction and testing of the overall combination.); Broos v. Barton, 142 F.2d 690, 691, 61 USPQ 447, 448 (CCPA 1944) (preparation of application in U.S. for foreign filing constitutes diligence); De Solms v. Schoenwald, 15 USPQ2d 1507 (Bd. Pat. App. & Inter. 1990) (principles of diligence must be given to inventor's circumstances including skill and time; requirement of corroboration applies only to testimony of inventor); Huelster v. Reiter, 168 F.2d 542, 78 USPQ 82 (CCPA 1948) (if inventor was not able to make an actual reduction to practice of the invention, he must also show why he was not able to constructively reduce the invention to practice by the filing of an application).

9.   The diligence of attorney in preparing and filing patent application inures to the benefit of the inventor. Conception was established at least as early as the date a draft of a patent application was finished by a patent attorney on behalf of the inventor. Conception is less a matter of signature than it is one of disclosure. Attorney does not prepare a patent application on behalf of particular named persons, but on behalf of the true inventive entity. Six days to execute and file application is acceptable. Haskell v. Coleburne, 671 F.2d 1362, 213 USPQ 192, 195 (CCPA 1982). See also Bey v. Kollonitsch, 866 F.2d 1024, 231 USPQ 967 (Fed. Cir. 1986) (Reasonable diligence is all that is required of the attorney. Reasonable diligence is established if attorney worked reasonably hard on the application during the continuous critical period. If the attorney has a reasonable backlog of unrelated cases which he takes up in chronological order and carries out expeditiously, that is sufficient. Work on a related case(s) that contributed substantially to the ultimate preparation of an application can be credited as diligence.).

10.   In the instant application, Applicant's only evidence is a screen shot of an email which shows no substantial material pertinent to the claimed invention. The Applicant has not attempted to provide any evidence regarding the diligence performed from 17 August 2003 until 13 November 2003, as alleged. Accordingly, the declaration submitted by the Applicant is insufficient to overcome the Silver (US 2005/0043996) reference.

Previous Claim Rejections - 35 USC § 101

11.   Claims 19 and 20 were rejected under 35 U.S.C. 101 because the claimed invention was directed to non-statutory subject matter. The Examiner appreciates the Applicant's prompt attention to these deficiencies and hereby withdraws such rejections.

Claim Rejections - 35 USC § 102

12.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the

rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13.   Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by *Silver, US Patent Publication No.*

US 2005/0043996 A1.

As per claim 1

Silver teaches:

-    Presenting a set of items for a bill for which payment is required (see at least page 4, paragraph 47)

-    Receiving user input identifying items from the set of items for payment by a particular person to form

    identified items (see at least pages 4-5, paragraphs 56-59)

-    Processing payment for the identified items (see at least pages 4-5, paragraphs 56-59)

-    Repeating the receiving and processing steps until all items in the set of items have been identified for

    payment (see at least pages 4-5, paragraphs 56-59)

As per claim 2

Silver teaches the method of claim 1, as described above.

Silver further teaches:

-    Wherein the processing step comprises: receiving credit card information from the particular person (see at

    least page 4, paragraph 48)

As per claim 3

Silver teaches the method of claim 2, as described above.

Silver further teaches:

- Wherein the credit card information is obtained from a magnetic strip on a credit card (see at least page 4, paragraph 48)

As per claims 4-6

Silver teaches the method of claim 1, as described above.

Silver further teaches:

- Wherein the data processing system is selected from one of a personal digital assistant or a tablet personal computer (see at least page 2, paragraphs 27-28)

- Wherein the bill is a restaurant bill (see at least page 2, paragraph 32)

- Wherein the data processing system processes the payment by sending payment information to a server data processing system in communication with the data processing system (see at least page 4, paragraphs 48-49)

As per claim 7

Silver teaches the method of claim 6, as described above.

Silver further teaches:

- Wherein the data processing system is in communication with the server data processing system using a wireless communications link (see at least page 2, paragraph 28)

As per claim 8

Silver teaches:

- Presenting the plurality of items on a graphical user interface (see at least pages 2-3, paragraph 32; pages 4-5, paragraphs 56-59)

- Receiving user input, selecting items from the plurality of items on the graphical user interface, to group the plurality of items into a set of accounts (see at least pages 2-3, paragraph 32; pages 4-5, paragraphs 56-59)

- Processing payment of the set of accounts (see at least pages 2-3, paragraph 32; pages 4-5, paragraphs 56-59)

As per claim 9

Silver teaches:

- Presenting means for presenting a set of items for a ill for which payment is required (see at least page 4, paragraph 32)

- Receiving means for receiving user input identifying items from the set of items for payment by a particular person to form identified items (see at least pages 4-5, paragraphs 56-59)

- Processing means for processing payment for the identified items (see at least pages 4-5, paragraphs 56-59)

- Repeating means for repeating initiation of the receiving means and processing means until all items in the set of items have been identified for payment (see at least pages 4-5, paragraphs 56-59)

As per claim 10

Silver teaches the system of claim 9, as described above.

Silver further teaches:

- Wherein the processing means comprises: means for receiving credit card information from the particular person (see at least page 4, paragraph 48)

As per claim 11

Silver teaches the system of claim 10, as described above.

Silver further teaches:

- Wherein the credit card information is obtained from a magnetic strip on a credit card (see at least page 4, paragraph 48)

As per claims 12-14

Silver teaches the system of claim 9, as described above.

Silver further teaches:

- Wherein the data processing system is selected from one of a personal digital assistant or a tablet personal computer (see at least page 2, paragraphs 27-28)

- Wherein the bill is a restaurant bill (see at least page 2, paragraph 32)

- Wherein the data processing system processes the payment by sending payment information to a server data processing system in communication with the data processing system (see at least page 4, paragraphs 48-49)

As per claim 15

Silver teaches the system of claim 14, as described above.

Silver further teaches:

- Wherein the data processing system is in communication with the server data processing system using a wireless communications link (see at least page 2, paragraph 28)

As per claim 16

Silver teaches:

- Presenting means for presenting the plurality of items on a graphical user interface (see at least pages 2-3, paragraph 32; pages 4-5, paragraphs 56-59)

- Receiving means for receiving user input, selecting items from the plurality of items on the graphical user interface, to group the plurality of items into a set of accounts (see at least pages 2-3, paragraph 32; pages 4-5, paragraphs 56-59)

- Processing means for processing payment of the set of accounts (see at least pages 2-3, paragraph 32; pages 4-5, paragraphs 56-59)

As per claim 17

Silver teaches:

- A bus system (see at least page 2, paragraph 22)

- A memory connected to the bus system, wherein the memory includes a set of instructions (see at least page 2, paragraph 22)

- A processing unit connected to the bus system (see at least page 2, paragraph 22)

- Wherein the processing unit executes the set of instructions to

    o Present a set of items for a bill for which payment is required (see at least pages 2-3, paragraph 32; pages 4-5, paragraphs 56-59)

    o Receive user input identifying items from the set of items for payment by a particular person to form identified items (see at least pages 2-3, paragraph 32; pages 4-5, paragraphs 56-59)

    o Process payment for the identified items (see at least pages 2-3, paragraph 32; pages 4-5, paragraphs 56-59)

    o Repeat the instructions to receive and to process until all items in the set of items have been identified for payment (see at least pages 2-3, paragraph 32; pages 4-5, paragraphs 56-59)

As per claim 18

Silver teaches:

- A bus system (see at least page 2, paragraph 22)

- A memory connected to the bus system, wherein the memory includes a set of instructions (see at least page 2, paragraph 22)

- A processing unit connected to the bus system (see at least page 2, paragraph 22)

- Wherein the processing unit executes the set of instructions to

    o To present the plurality of items on a graphical user interface (see at least pages 2-3, paragraph 32; pages 4-5, paragraphs 56-59)

    o   Receive user input, selecting items from the plurality of items on the graphical user interface, to group the plurality of items into a set of accounts (see at least pages 2-3, paragraph 32; pages 4-5, paragraphs 56-59)

    o   Process payment of the set of accounts (see at least pages 2-3, paragraph 32; pages 4-5, paragraphs 56-59)

As per claim 19

Silver teaches:

-   First instructions for presenting a set of items for a bill for which payment is required (see at least page 4, paragraph 47)

-   Second instructions for receiving user input identifying items from the set of items for payment by a particular person to form identified items (see at least pages 2-3, paragraph 32; pages 4-5, paragraphs 56-59)

-   Third instructions for processing payment for the identified items (see at least pages 2-3, paragraph 32; pages 4-5, paragraphs 56-59)

-   Fourth instructions for repeating initiation of the second instructions and third instructions until all items in the set of items have been identified for payment (see at least pages 2-3, paragraph 32; pages 4-5, paragraphs 56-59)

As per claim 20

Silver teaches:

-   First instructions for presenting the plurality of items on a graphical user interface (see at least pages 2-3, paragraph 32; pages 4-5, paragraphs 56-59)

-   Second instructions for receiving user input, selecting items from the plurality of items on the graphical user interface, to group the plurality of items into a set of accounts (see at least pages 2-3, paragraph 32; pages 4-5, paragraphs 56-59)

- Third instructions for processing payment of the set of accounts (see at least pages 2-3, paragraph 32; pages 4-5, paragraphs 56-59)

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas M. Hammond III whose telephone number is 571-270-1829. The examiner can normally be reached on Monday - Friday, 7AM - 5PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Kyle can be reached on 571-272-6746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thomas M Hammond III
Patent Examiner, Art Unit 3695
US Patent & Trademark Office
09 April 2009

/Thu Thao Havan/
Primary Examiner, Art Unit 3695